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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,876	06/13/2002	Andreas Hadler	DNAG 230	2623
24972	7590	09/20/2004	EXAMINER	
FULBRIGHT & JAWORSKI, LLP 666 FIFTH AVE NEW YORK, NY 10103-3198			ALIMENTI, SUSAN C	
			ART UNIT	PAPER NUMBER

3644

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/018,876

**Applicant(s)**

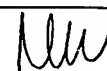
HADLER ET AL.

**Examiner**

Susan C. Alimenti

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 24 and 26-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24 and 26-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This Office Action is in response to amendments filed 07 September 2004, following an interview with James Crawford on 07 September 2004, as noted in the interview summary attached hereto.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 24 and 26-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 24, the phrase "a hard penetrating that penetrates" in line 2 is awkward and confusing and requires correction. Further claim 24 recites the limitation "the hard penetrating core" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claims 26-46 are also rejected as being dependent upon the rejected subject matter of base claim 24.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 24, 26-33, 35-39, 43 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Wood (US 1,134,797).

Wood discloses the claimed invention as best understood, more specifically an expanding projectile comprising a jacket 3, a fragmenting soft core 2, and a hard penetrating core 4 disposed in front of said soft core 2 as seen in the direction of trajectory. The soft core 2 and penetrating core 4 are enclosed completely by said jacket 3.

The nose of the projectile is considered to be edge 5 of penetrating core 4, wherein regarding claims 26-28 said nose has a recess defined as the hollow conical interior 40 (See Examiner's reference character, Figure 4) of penetrating core 4 and the tip angle is considered to be within the range of 30-90 degrees.

Regarding claims 29-30, cavity 41 adjoins recess 40 and extends no more than 75% of the length of the soft core 2.

Regarding claim 31 and 33, edge 5 is a circular annular surface and is perpendicular to the midline of the projectile.

Regarding claim 32, the shape of cavity 41, which is part of recess 40, is considered to generally conform to the shape of the rear of the projectile and vice versa.

Regarding claim 35, Wood shows the nose 5 to be a flat head in Figures 3-4.

Regarding claims 36-39, the projectile tips 42A, 42B (See Examiner's reference character in Figures 1-2) are considered to have a shape matched to required flight characteristics. The tip is formed from solid cap 1 and further has a rear shaft portion that extends into the penetrating core.

Regarding claim 41, tip 42A is considered to have a sharp edge.

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Regarding claims 43 and 44, the thickness of jacket wall 3, as seen in at least Figures 1 and 2, decreases in thickness from the rear toward the forward front edge.

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable Wood as applied to claim 24 above, and further in view of Winter (US 6,148,731).

Wood discloses the claimed invention, as best understood, except the use of lead free materials in the manufacture of the projectile is not positively stated. Winter discloses an expansion projectile that is made from lead-free materials. Winter explains that a lead core tends to splinter upon impact causing undesired contamination for instance in hunting applications, and the use of non-lead materials could avoid such a situation (Winter, col.1, lns.19-35). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use non-lead materials when making expanding bullets in order to avoid contamination of lead into the area surrounding the intended target and the target itself.

8. Claims 34, 40 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood in view of Winter as applied to claims 24, 36, 38 and 45 above, and further in view of Pejsa (US 4,776,279).

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Wood discloses the claimed invention, as best understood, except it is not clear what the tip is made of. Pejsa discloses a projectile in the same field of endeavor, that being expanding or fragmenting projectiles, that teaches using a plastic material to construct the hard penetrating core and tip 30. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the Wood's tip out of a plastic material, since it has been held to be within the general skill of a worker in the art to select a known material based upon its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

#### *Allowable Subject Matter*

9. Claim 42, as best understood, would be allowable if rewritten to overcome the rejection under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### *Response to Arguments*

10. Applicant's arguments filed 30 June 2004 have been fully considered but they are not persuasive. In response to the crux of applicant's arguments, that Wood's mushrooming bullet does not anticipate the claimed subject matter because he discloses a materially different device, the examiner respectfully disagrees. Applicant contends that, "the conical body in Wood is lacking... the material deformation of the head core and of the body", and more broadly that the "break-up behaviors" of the present invention are not shown by wood (Arguments 6/30/04, p.1 ¶5). The limitations that applicant argues focuses on vague functional language that Wood is considered *to be capable of* performing when in use. This argument is lacking basis until the

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claimed structure can reflect such characteristics and alleged distinctions, and at this point it does not. For these and the above reasons the examiner maintains the rejections of claims 24, and 26-46.

### *Conclusion*

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan C. Alimenti whose telephone number is 703-306-0360. The examiner can normally be reached on Monday-Friday, 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on 703-305-7421. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SCA

A handwritten signature in black ink, appearing to read "Teri P. Luu", is positioned above the printed name and title.

**TERI P. LUU**  
**SUPERVISORY PRIMARY EXAMINER**